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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,097	10/31/2003	Edward H. Overstreet	AB-378U	9705

23845 7590 05/18/2006

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EXAMINER

FAULCON JR, LENWOOD

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/698,097	Applicant(s) OVERSTREET ET AL.	
	Examiner Lenwood Faulcon, Jr.	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 27, 2006, has been entered.

Response to Arguments

2. Applicant's arguments filed April 27, 2006, have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 102

3. Claims 1-4, 7, 10-12, 14, 16-17, 19, 21-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by John (U.S. Patent No. 6,066,163) as applied in the previous Office Action November 30, 2005 and as applied above.

In regards to claims 1, 10 and 21, Examiner maintains the position that the John reference does teach of at least two electrode contacts (reference #s 76 and 78, and see col. 10 lines 7-14) that are capable of provoking evoked action potentials in a patient's tissue (col. 9 lines 51-52). Examiner interprets two electrodes (76 and 78) as being two electrode contacts, similarly to the electrode contacts as claimed by Applicant. Further, Applicant admits that the John reference teaches of "a direct brain stimulation system with electrodes dispersed over different portions of the brain," which

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appears to meet the broad limitations of claims 1, 10 and 21, of having at two electrode contacts through which electrical stimuli are applied to a patient's tissue.

In regards to claim 16, which is directed to a cochlear implant, John also teaches of the implantable system and method as being capable of functioning as an auditory prosthesis (col. 14 lines 63-67), which Examiner interprets as an auditory prosthesis to include a cochlear implant. In regards to Applicant's argument that the John reference fails to teach determining the appropriate stimulation level, the John reference teaches of modifying the system's stimulation parameters to provide safe and efficient treatment (col. 4 lines 10-15); notwithstanding Examiner's earlier position that the optimum level of patient comfort also can be interpreted as finding the "appropriate" stimulation level for the system.

Further regarding claims 1, 10, 16 and 21, Examiner takes the position that John reference discloses the use of a separate electrode for sensing/monitoring for the occurrence of an evoked action potential (col. 4 lines 25-35, col. 5 lines 20-23). Further, Examiner takes the position that the John reference discloses adjusting the intensity of the electrical stimuli while monitoring for the occurrence of an evoked action potential (Figure 2, col. 14 lines 46-50).

In regards to previous rejection of claims 5, 6, 8, 9, 13, 15, 18 and 20, Examiner again notes that the John reference teaches that the implantable system and method can function as a multi-channel implantable auditory prosthesis (col. 14 lines 63-67), and Examiner interprets the auditory prosthesis as described by John to be analogous to the multi-channel implantable system as taught by Doyle.

Claim Rejections - 35 USC § 103

4. Claims 5-6, 8-9, 13, 15, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over John (U.S. Patent No. 6,066,163) as applied to claims 1-4, 7, 10-12, 14, 16-17, 19 and 21-23 above, in view of Doyle (U.S. Patent No. 6,175,767) as applied in the previous Office Action of November 30, 2005.

Double Patenting

5. Claims 1-20 stand provisionally rejected on the ground of nonstatutory double patenting over claims 1-6 of copending Application No. 10/698,098. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a neurostimulator implant system that applies electrical stimulation to the tissue of a patient by multiple electrode contacts, adjusting the intensity of the applied electrical stimulus to which the first presence of an evoked compound action potential is detected, determining the intensity threshold level, creating a contour of intensity levels for use in defining operational parameters of the neurostimulator implant system.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

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copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Faltys et al. (U.S. Patent No. 5,626,629), King (U.S. Patent No. 5,702,429), Nygard et al. (U.S. Patent No. 5,758,651), Ren et al. (U.S. Patent No. 5,776,179), Hochmair et al. (U.S. Patent No. 5,876,443), Faltys et al. (U.S. Patent No. 6,157,861), Carter et al. (U.S. Patent No. 6,205,360), Overstreet (WO 03/015863), Faltys (U.S. 10/218,616).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenwood Faulcon, Jr. whose telephone number is 703-305-0582. The examiner can normally be reached on Monday-Thursday from 9 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes, can be reached on 703-305-0582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).



Lenwood Faulcon, Jr.



George Manuel
Primary Examiner